

traverse on September 25, 1998. Applicants hereby reaffirm their election with traverse.

The Office Action bases restriction between the claims of Groups I and II because "[i]n the instant case the product as claimed can be used in a materially different process...as evidenced by the fact that the method of Group II does not require the particulars of the product of Group I to proceed." Claim 30 has been amended and specifically sets forth the particulars of the product as defined by claim 1. Consequently the basis for restriction between the claims in Groups I and II no longer exists, and therefore the restriction is improper and should be withdrawn.

The Office Action also requires restriction between the product of Group I and the method of Group III for substantially the same reason set forth in the restriction between Groups I and II. In view of the above Amendment, the particulars of the product of claim 1 are now required in the assembly method of Group III, and therefore the restriction is improper and should be withdrawn.

In conclusion the restriction requirement of record is improper, should be withdrawn, and all the claims should be examined on the merits.

INFORMATION DISCLOSURE STATEMENT

The Office Action indicates that the IDS filed February 25, 1998 fails to comply with §§ 1.97, 1.98 because the references were not published prior to the filing of the above-identified application. Applicants respectfully disagree.

Applicants did not file an Information Disclosure statement on February 25, 1998, as

alleged. Applicants, however, did file a statement pursuant 37 C.F.R. § 1.56 regarding copending applications, which is required by statute, and PTO procedure, for the Examiner's consideration. The applicants are well aware that these applications will not be cited on a PTO-1449 or on the front face of a patent.

Consequently, comments made in the Office action regarding the consideration of these applications is inappropriate, contrary to PTO procedures, and the governing case law.

Applicants have filed several Information Disclosure Statements (IDS) pursuant to 37 C.F.R. §§§ 1.56, 1.97 and 1.98 on January 22, 1998, and on May 14, 1998. Copies of the postcard receipts verifying that the PTO received the January and May Information Disclosure Statements including the PTO Form-1449 with the attached references, Exhibit Nos. 1 and 2, are attached. Inexplicably the October Office Action makes no reference to either the January or May IDS which was received by the PTO. Additional copies of the two previously filed PTO Form-1449s are attached for the Examiner's processing, without fee or certification because the documents were timely filed, received, but apparently lost. It is requested that the Examiner consider all the cited documents and initial the Form-1449 in the appropriate manner in accordance with the MPEP § 609. It is also noted that the second IDS was filed in and received by the Examiner's Group.

Applicants also request that the propriety of the timely submissions pursuant to 37 C.F.R. §§§ 1.56, 1.97 and 1.98 be acknowledged.

REJECTION UNDER 35 U.S.C. § 112

Claims 1-21 have been rejected under 35 U.S.C. § 112, second paragraph. Applicants respectfully submit that in view of the clarifying amendment to claim 1 supra, claim 1 fully satisfies the requirements of 35 U.S.C. § 112. Accordingly, the rejection should be withdrawn.

REJECTIONS UNDER 35 U.S.C. § 102

1. U.S. Patent No. 5,723,003 (Winston)

Claims 1 - 3, 14 - 16, 21, 22, 24 and 25 have been rejected under 35 U.S.C. § 102 as being anticipated by the Winston patent. Applicants respectfully traverse this rejection.

The Office Action states that Figure 9 of the Winston patent shows a stent member (34), a graft member (10) and a ribbon (14). Applicants disagree because the Winston patent does not teach or suggest the use of a ribbon which secures the stent to the graft.

The Winston patent discloses that the expandable graft assembly of Figure 9 includes stents 12, 14 and inner stents 34 (col. 6, lines 47 - 50). The purpose of the inner stent 34 is to "hold the graft 10 against the inner circumferential surface of the outer stents" (col. 6, lines 51 - 53). The purpose of the outer stents 12 and 14 is "the first stent 12 retains the graft within the desired position relative to the damaged section of the passage, and the second stents support the graft along the length thereof" (col. 6, lines 24-29). In contrast, as discussed above, the claimed ribbon secures a stent to the graft. Consequently, there is no "stent" element interposed between element 14 alleged to be a ribbon by the Examiner and the graft depicted in the Winston patent. Since the Winston patent does not contain any express or inherent teaching of each and every

feature of the pending claims, there can be no anticipation. It is therefore respectfully submitted that the rejection under 35 U.S.C. § 102 based upon the Winston patent is improper and should be withdrawn.

2. U.S. Patent No. 5,545,211 (An)

Claims 1, 4, 7, 9 - 13, 21 and 26 have been rejected under 35 U.S.C. § 102 as being anticipated by the An patent. Applicants respectfully traverse this rejection.

The Office Action states that Figure 5 of the An patent depicts a stent 10, a graft 13 and a ribbon 14. Applicants disagree.

The An patent expressly discloses the use of a wrapped mesh 13 which is disposed "such that it is not exposed" (col. 3, lines 66 - 67). Further, the An patent expressly discloses that the "entire mesh includes a coating 14 of a silicon rubber" (col. 4, lines 1 - 2). Consequently, contrary to the allegations set forth in the Office Action, mesh element 13 cannot be construed to be a "graft," and silicone coating 14, which covers the "entire" mesh cannot be construed as a ribbon. Since the An patent does not expressly or inherently teach each and every feature of the pending claims, there can be no anticipation. It is therefore respectfully submitted that the rejection under 35 U.S.C. § 102 based upon the An patent is improper and should be withdrawn.

3. U.S. Patent No. 5,637,113 (Tartaglia)

Claims 1, 19 and 20 have been rejected under 35 U.S.C. §102 as being anticipated by the Tartaglia patent. Applicants respectfully traverse this rejection.

The Office Action states that the Tartaglia patent teaches in Figure 5 a "stent 72 having an inner and outer surface," a "graft member (84)," and "a ribbon 80 covering only a portion of at least one of the inner or outer surfaces of the member and securing the stent member and graft member to one another." Applicants disagree.

Initially it is noted that Figure 5 of the Tartaglia patent does not show any element 80, which feature is shown in Figures 9 – 11. The Tartaglia patent relates to a stent that is wrapped with an outer polymeric film which is loaded with releasable therapeutic agents (col. 1, lines 42 – 44). There is no express teaching in the Tartaglia patent that the pharmaceutical bearing polymeric film should function as a graft in the context contemplated by applicants.

According to the Tartaglia patent the polymeric film is attached to the stent by tightly wrapping the polymeric film at least once around the stent (col. 6, lines 32 - 37). This coiled polymeric film is secured about the stent

...by at least one piece or strip of elastic material 80. One end 82 of at least one such piece or strip of elastic material is attached to the exterior end portion 78 of the coil of polymeric material, and an opposing end 83 of the piece of elastic material is attached to another portion 84 of the exterior of the wrapped coil of polymeric material.

(col. 6, lines 40 - 49).

Thus there is no teaching within the four corners of the Tartaglia patent that the strips 80, which the PTO is apparently construing as the claimed ribbon, adhere to a surface of the stent, as required by the now amended claims. Thus, it is respectfully submitted that the rejection under 35 U.S.C. §102 based upon the Tartaglia patent is improper and should be withdrawn.

Serial No.: 08/896,805
Amendment

Dkt. No 3359-4005US1 (MP/114A)

CONCLUSION:

It is respectfully submitted that in view of the now amended claims, the pending claims are in condition for allowance, and that action is earnestly solicited.

AUTHORIZATIONS:

The Assistant Commissioner is hereby authorized to charge any additional fees which may be required for the timely consideration of this amendment under 37 C.F.R. §§ 1.16 and 1.17, or credit any overpayment to Deposit Account No. 13-4500, Order No. 3359-4005US1.

Respectfully submitted,

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Date: February 3, 1999

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FEB 05 1999
Group 3700

Case No. 3359-4005US1

Serial No. 08/896,805

Date Due N/A

Atty MSM/lep

Date This Paper is being Filed February 25, 1998

Entitled KINK RESISTANT STENT GRAFT

The return of this post card, properly stamped, will acknowledge receipt in the Patent & Trademark Office of the following:

1. - Submission Pursuant to 37 C.F.R. § 1.56

HAND DELIVER TO GROUP ART UNIT 3306